

ESTTA Tracking number: **ESTTA988699**

Filing date: **07/18/2019**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Marvel Characters, Inc.
Granted to Date of previous extension	07/24/2019
Address	500 SOUTH BUENA VISTA STREET BURBANK, CA 91521 UNITED STATES
Attorney information	LINDA K. MCLEOD KELLY IP LLP 1300 19TH ST NW SUITE 300 WASHINGTON, DC 20036 UNITED STATES linda.mcleod@kelly-ip.com, clint.taylor@kelly-ip.com, lit-docketing@kelly-ip.com no phone number provided

Applicant Information

Application No	87754060	Publication date	03/26/2019
Opposition Filing Date	07/18/2019	Opposition Period Ends	07/24/2019
Applicant	BlackBerry Limited 2200 University Avenue East Waterloo, Ontario, N2K0A7 CANADA		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Design and development of computer software; Platform as a service (PAAS) and Software as a service (SAAS) services featuring software and software platform for use in performing vulnerability assessment and penetration testing; providing temporary use of on-line non- downloadable computer software for endpoint security, malware analysis, vulnerability testing, penetration testing, and vulnerability assessment

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4737881	Application Date	05/28/2014
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Registration Date	05/19/2015	Foreign Priority Date	NONE
Word Mark	JARVIS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2013/09/10 First Use In Commerce: 2013/09/10 Computer application software that may be downloaded via global computer networks and electronic communication networks for use in connection with mobile computers, mobile phones, and tablet computers, namely, software for use as a voice controlled personal digital assistant		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	JARVIS		
Goods/Services	Entertainment services; television programs; motion picture films; comic books; video games; computer games; computer software; mobile applications; clothing; and all other goods and services indicated in the Notice of Opposition.		

Attachments	86294162#TMSN.png(bytes) JARVIS - Notice of Opposition.pdf(973327 bytes)
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Signature	/Linda K. McLeod/
Name	LINDA K. MCLEOD
Date	07/18/2019

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>MARVEL CHARACTERS, INC.,</p> <p style="text-align: center;">Opposer</p> <p style="text-align: center;">v.</p> <p>BLACKBERRY LIMITED,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No.:</p> <p>Mark: JARVIS</p> <p>Serial No.: 87754060</p> <p>Filed: January 12, 2018</p>
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NOTICE OF OPPOSITION

Opposer, Marvel Characters, Inc., a corporation of the State of Delaware having a principal place of business at 500 South Buena Vista Street, Burbank, California, 91521, believes that it is being damaged, and will be damaged, by the registration of BlackBerry Limited's ("Applicant") JARVIS mark shown in Application Serial No. 87754060, and hereby opposes the same. As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to Opposer's own acts, and upon information and belief as to other matters:

Opposer and its Business

1. Marvel Characters, Inc., by and through its predecessors-in-interest and related companies (collectively, "Opposer" or "Marvel"), is one of the world's most prominent character-based entertainment companies, with a library of more than 8,000 characters featured in a variety of media for more than seventy-five years.

2. Opposer's characters include the well-known and famous characters IRON MAN, SPIDER-MAN, X-MEN, CAPTAIN AMERICA, FANTASTIC FOUR, WOLVERINE, BLACK PANTHER, and THE INCREDIBLE HULK, just to name a few.

3. For many years, Opposer has engaged in a vast licensing program of its characters and character names under which it licenses and has licensed the use of its properties and characters and character names in connection with a wide variety of products and services including, but not limited to, entertainment services, motion picture films, television programs, comic books, interactive and online games, computer games, computer game software, video games, mobile applications, apparel, headwear, footwear, toys, eyewear, linens, towels, jewelry, bags, food and beverages, and theme parks, among others.

Opposer's Common Law Rights in Opposer's JARVIS Mark

4. Opposer owns the enormously successful IRON MAN and THE AVENGERS entertainment franchises that include comic books, films, entertainment services, video games, mobile applications, and a wide variety of merchandise (the "IRON MAN and AVENGERS Franchises"). Opposer's "Iron Man" story revolves around Tony Stark, a wealthy industrialist who has invented suits of armor that give him super-human powers. When wearing the suits, Tony Stark becomes the IRON MAN character.

5. Part of Opposer's enormously successful IRON MAN and AVENGERS Franchises is Opposer's unique EDWIN JARVIS and JARVIS name and mark (collectively, "Opposer's JARVIS Mark").

6. In November 1964, Opposer first used Opposer's JARVIS Mark in comics for a character named EDWIN JARVIS, who is known and referred to as JARVIS by both Opposer and the public. Opposer's JARVIS character is the personal assistant to Tony Stark.

7. In the 1960's, Opposer's IRON MAN character was the founding member of a team of characters known as THE AVENGERS. The members of THE AVENGERS team have included famous characters such as IRON MAN, CAPTAIN AMERICA, THOR, SPIDER-MAN, and THE INCREDIBLE HULK, among many others. Opposer's JARVIS character has also served as the personal assistant for THE AVENGERS team.

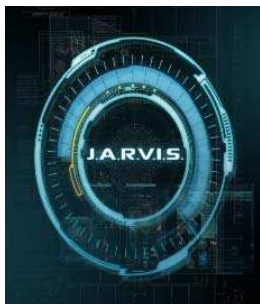
8. For decades, Opposer's JARVIS Mark has appeared in connection with countless comic books featuring IRON MAN, THE AVENGERS, and others, including the representative examples below.



9. Opposer's JARVIS Mark is also used in Opposer's tremendously successful films, first appearing in Opposer's 2008 film *Iron Man*. In that film, the JARVIS Mark is used as the name of Tony Stark's computerized artificial intelligence assistant. Opposer's *Iron Man* film was a commercial and success earning over \$315 million in domestic box office revenue. The film is still available for viewing by instant streaming on amazon.com and iTunes, among other streaming services.

10. Opposer's JARVIS Mark is also used in Opposer's films *Iron Man 2* (2010), *Iron Man 3* (2013), *The Avengers* (2012), and *Avengers: Age of Ultron* (2015). In each of those films, Opposer's JARVIS Mark is used for Tony Stark's personal assistant that takes care of everything in his home. Each of those films were enormous commercial successes, and each film earned hundreds of millions of dollars in domestic box office revenue. Indeed, *The Avengers* is the eight highest-grossing film of all time generating over \$620 million in domestic box office revenue, and *Avengers: Age of Ultron* is the seventeenth highest-grossing film of all time generating over \$450 million in domestic box office revenue. These films are still available for viewing by instant streaming on amazon.com and iTunes, among other streaming services.

11. In Opposer's films, Opposer's JARVIS Mark is used in connection with the JARVIS character that speaks and appears both on a computer screen and downloaded as software into various "Iron Man" armor suits, as shown below.



12. In addition to films, Opposer's JARVIS Mark is also used in Opposer's television shows including the television series *Agent Carter* (2015-2016), among others. Opposer's *Agent Carter* television series is still available for viewing by instant streaming on amazon.com and iTunes, among other streaming services.

13. In addition to iconic comics, blockbuster films, and television shows, Opposer's JARVIS Mark and JARVIS character has also appeared in numerous video games including *Iron Man* (2008), *Iron Man 2* (2010), *Iron Man 3* (2013), and *Lego Marvel Super Heroes* (2013), among others. These video games are available for purchase and/or downloading on a number of video game consoles such as the PlayStation 3, PlayStation 4, Xbox 360, and Xbox One, and are also available for purchase and/or downloading on iTunes and Google Play for mobile devices.

14. Consistent with Opposer's long history of using and licensing its entertainment properties, character names, and elements, Opposer and/or its licensees over the years have sold and distributed merchandise bearing Opposer's JARVIS Mark. These products include apparel, as shown in the example below.



15. In addition, Opposer for many years has offered a computer software application under Opposer's JARVIS Mark, as shown in the representative examples below. Opposer's computer software application offered under Opposer's JARVIS Mark is available for download on iTunes and has been downloaded hundreds of thousands of times.



Opposer's Registration Rights in Opposer's JARVIS Mark

16. In addition to its longstanding common law rights, Opposer owns the following valid and subsisting United States trademark registration for Opposer's JARVIS Mark:

Mark	Reg. No. Date	Class/ Goods / Date of First Use
JARVIS	4737881 19-MAY-2015	Int. Cl. 9 Computer application software that may be downloaded via global computer networks and electronic communication networks for use in connection with mobile computers, mobile phones, and tablet computers, namely, software for use as a voice controlled personal digital assistant (First use 09/10/2013)

Attached as Exhibit A are printouts of the TSDR and assignment records from the USPTO database showing particulars of the mark in the chart above.

17. The above registration is valid and subsisting and constitutes *prima facie* evidence of Opposer's ownership of and exclusive rights to use Opposer's JARVIS Mark in commerce for the products recited in the registration. (The goods and services listed in Paragraphs 3-16 are collectively referred to as "Opposer's Goods and Services.")

18. Opposer and/or its licensees and related companies have spent considerable effort and resources advertising and promoting Opposer's JARVIS Mark, including in connection with Opposer's IRON MAN and AVENGERS Franchises and Opposer's Goods and Services for many decades. As a result of these efforts, Opposer's JARVIS Mark has long been well known, and Opposer has established a strong association and identification in the minds of the public between Opposer, Opposer's Goods and Services, and Opposer's JARVIS Mark.

Applicant and its JARVIS Mark

19. Applicant BlackBerry Limited is a Canadian corporation with an address of 2200 University Avenue East, Waterloo, Ontario, Canada N2K0A7.

20. Applicant is the listed owner of Application Serial No. 87754060 (the "Application"), filed on January 12, 2018 under Section 1(b), 15 U.S.C. § 1051(b), for the mark JARVIS ("Applicant's JARVIS Mark") for "design and development of computer software; Platform as a service (PAAS) and Software as a service (SAAS) services featuring software and software platform for use in performing vulnerability assessment and penetration testing; providing temporary use of on-line non- downloadable

computer software for endpoint security, malware analysis, vulnerability testing, penetration testing, and vulnerability assessment” in Class 42 (“Applicant’s Services”).

21. On March 26, 2019, the Application was published for opposition in the *Trademark Official Gazette* (TMOG). On April 24, 2019, Opposer timely filed a request for extension of time to oppose the Application.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

22. Opposer repeats and realleges each and every allegation set forth above.

23. Opposer has priority based on its prior use in commerce of Opposer’s JARVIS Mark for Opposer’s Goods and Services since before the filing date of the Application and any date of first use that Applicant can prove. Opposer also has priority based on its pleaded valid and subsisting prior-issued registration for Opposer’s JARVIS Mark.

24. Applicant’s JARVIS Mark and Opposer’s JARVIS Mark are identical in sound, appearance, connotation, and commercial impression.

25. Applicant’s Services are identical and/or related to Opposer’s Goods and Services advertised, promoted, and/or sold by Opposer in connection with Opposer’s JARVIS Mark.

26. Accordingly, Applicant’s JARVIS Mark shown in Application Serial No. 87754060 so resembles Opposer’s previously used and registered Opposer’s JARVIS Mark, as to be likely, when registered and used in connection with Applicant’s Services, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

27. This likelihood of confusion is materially increased based on Opposer's merchandising and licensing of Opposer's JARVIS Mark and JARVIS character (and other marks, characters, and elements of Opposer's IRON MAN and AVENGERS Franchises) with significant commercial success as discussed above. Consumers are thus likely to mistakenly believe that Applicant's Services offered under Applicant's JARVIS Mark, which is identical to Opposer's JARVIS Mark, are affiliated with Opposer, Opposer's JARVIS Mark, Opposer's IRON MAN and AVENGERS Franchises, and/or Opposer's Goods and Services, or are licensed, sponsored, endorsed, or approved by Opposer.

WHEREFORE, Opposer believes that it is being damaged, and will be damaged, by the registration of the mark shown in Application Serial No. 87754060, and requests that the opposition be sustained, and that registration to Applicant be refused.

A filing fee has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 506154.

Respectfully submitted,

Dated: July 18, 2019

By: /Linda K. McLeod/
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Notice of Opposition
Serial No. 87754060

Attorneys for Opposer
Marvel Characters, Inc.

EXHIBIT A

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Mark: JARVIS

JARVIS

US Serial Number: 86294162

Application Filing Date: May 28, 2014

US Registration Number: 4737881

Registration Date: May 19, 2015

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 19, 2015

Publication Date: Mar. 03, 2015

Mark Information

Mark Literal Elements: JARVIS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Computer application software that may be downloaded via global computer networks and electronic communication networks for use in connection with mobile computers, mobile phones, and tablet computers, namely, software for use as a voice controlled personal digital assistant

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 10, 2013

Use in Commerce: Sep. 10, 2013

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Marvel Characters, Inc.

Owner Address: 500 South Buena Vista Street
Burbank, CALIFORNIA UNITED STATES 91521

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Catherine Bridge

Attorney Primary trademarks@disney.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent CATHERINE BRIDGE
Name/Address: THE WALT DISNEY COMPANY
500 S BUENA VISTA ST
BURBANK, CALIFORNIA UNITED STATES 91521-0007

Phone: 818-560-1000

Fax: 818-848-6424

Correspondent e-mail: trademarks@disney.com cpinkus@marvel.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 19, 2015	REGISTERED-PRINCIPAL REGISTER	
Mar. 03, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Mar. 03, 2015	PUBLISHED FOR OPPOSITION	
Feb. 11, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jan. 28, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70997
Jan. 28, 2015	ASSIGNED TO LIE	70997
Jan. 07, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 06, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jan. 06, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jan. 06, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jul. 24, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jul. 24, 2014	NON-FINAL ACTION E-MAILED	6325
Jul. 24, 2014	NON-FINAL ACTION WRITTEN	68788
Jul. 23, 2014	ASSIGNED TO EXAMINER	68788
Jun. 10, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 31, 2014	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 19, 2015